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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,849	05/09/2001	Bruce R. David	10420/12	3674

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EXAMINER

CADUGAN, ERICA E

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 06/18/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

# Advisory Action

Application No.

09/851,849

Applicant(s)

DAVID ET AL.

Examiner

Erica E Cadugan

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: \_\_\_\_\_

  
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SUPERVISORY PATENT EXAMINER  
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Continuation of 5. does NOT place the application in condition for allowance because: Applicant's request for reconsideration appears to be based on two main arguments: firstly, that the attachment device taught by Woods is less, not more, rigid than that taught by Dunlap, and secondly, that there is no motivation absent hindsight to combine Dunlap and Woods in the manner set forth in the office action mailed 3/20/2003. However, these arguments are not persuasive. Firstly, it is noted that counsel's statements regarding the rigidity of Woods' attachment device do not appear to be factually supported. Furthermore, regarding the motivation, it is noted that as set forth in the office action mailed 3/20/2003, Dunlap teaches that his support plate "may be secured to the workpiece top surface by any usual clamping means, not shown, or by any of the usual adhesives so as to be removable from the workpiece" (col. 4, lines 44-49, for example), which provides a specific teaching that Dunlap's attachment device can be replaced with some other clamping device. Additionally, note that Woods teaches benefits of the particular attachment device taught thereby (see col. 2, lines 7-15, for example), particularly that the lock bolts may be inserted, locked, unlocked, and removed all from one side, and that the lock bolts apply compression forces over a large area so that there is no point loading which (point loading) might cause distortion (col. 2, lines 7-15). Thus, to have substituted a known clamping device that has a specific benefit (i.e., Woods' device) for a clamping device that Dunlap explicitly teaches can be replaced "with any usual clamping means" is considered to be obvious to one having ordinary skill in the art.

Regarding Applicant's particular assertion that since Woods' drill units are mounted for movement in both X and Y directions, they must inherently be less rigid and stable than Dunlap's set-up (page 3, second paragraph of the request for reconsideration), it is noted that the fact that the drill units are capable of X and Y movement at some points in time does not appear to be relevant to the rigidity or stability of the clamping system taught by Woods. Note that the drill units are clamped to the bobbins 30 extending through the wing at some points in time (col. 3, lines 16-18, for example).

Note that Applicant has argued that using fasteners that extend through the workpiece is undesirable because such fasteners leave undesirable features or holes in the product or workpiece used. However, this is not persuasive. It is noted that Applicant's invention would also leave holes in the product or workpiece.

Applicant has asserted (page 5 of the request for reconsideration) that the references do not teach many of the claim limitations. However, this is not persuasive. Firstly, regarding the "aircraft skin lap router apparatus", it is noted that Dunlap teaches the router apparatus (Figures 8 and 9 as described by the previous office action). If Applicant is arguing that Dunlap does not specify that the router apparatus is used to rout an "aircraft skin", note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, there appears to be no reason why Dunlap's router could not be used to rout an "aircraft skin". Regarding the other assertions, note that Applicant has asserted that MPEP section 2142 sets forth that "[i]n order to establish a prima facie case of obviousness, the prior art references must teach or suggest all the claim limitations". Firstly no such statement is found in MPEP section 2142. Secondly, this assertion would appear to apply more to anticipatory references (i.e., 35 USC 102) rather than obviousness situations (i.e., 35 USC 103). If Applicant is asserting that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicant is asserting that "the Examiner has cited no reference" for "a nylon guide, or for a bearing mounted on the platform and interfacing with the nylon guide", "a router having a vertical adjustment within one-thousandth of an inch, or for a router whose source of power is electric or pneumatic", for example, and also stated that "[s]ince the Examiner has not cited references for at least several limitations of the claimed inventions, a prima facie case of obviousness has not been established." It is noted however, that the rejection in question was a 103 obviousness rejection that set forth the following:

"[n]ote that design features such as the shape and composition of the guide, particular "three-fluted" end mill used, "grips on the router", and power source for the router, if not already taught in Dunlap, would be obvious to one possessing ordinary skill in the art as design variants that are non-critical and/or within the knowledge of the ordinary skilled artisan."

In the instant case, one having ordinary skill in the art would have the knowledges necessary to select from known design variants as described above. For example, specifically regarding the nylon material, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized whatever material was desired or expedient, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Insofar as Applicant's arguments previously set forth apply to the combination of Dunlap and Woods with Stornetta, the above responses also apply.